

Serial No. 10/085,355
Art Unit: 1653

REMARKS

Claims 1-3 and 8-13 are pending in the above-identified patent application.

Reconsideration is respectfully requested. In an effort to advance the prosecution of this application, Claims 4-7 and 14-21 are cancelled and Claims 1, 2, 11 and 13 are amended to restrict the scope thereof to Applicant's preferred compositions. At the outset, Applicant notes with appreciation the withdrawal of a number of rejections from the first Office Action, thereby reducing the number of issues to be addressed herein. The foregoing amendment is believed to address the remaining issues and place the above-identified patent application in condition for allowance.

Specifically, Claim 1 is amended to limit the scope thereof to a protein that stimulates CCK release selected from the group consisting of casein, whey protein and soy protein, to limit the C₁₂₋₁₈ fatty acids component to at least 50 weight percent oleic acid with the remainder being other C₁₂₋₁₈ fatty acids that stimulate CCK release and to limit the extract providing a proteinase inhibitor to extracts of potato, soy or beans. Claim 2 is amended to recite the list of sources of calcium from Claim 6. As a result of these amendments, Claims 4-7 are cancelled. Claim 11 is amended to remove the comma between "artificial" and "dyes" thereby obviating the objection thereto. Claim 13 is amended to recite that it depends from Claim 12, thus correcting the inadvertent deletion of the dependency in the previous amendment, thereby obviating the rejection thereof under the second paragraph of 35 U.S.C. §112. The helpfulness of the Examiner in calling these latter two points to Applicant's attention in the Final Office Action under reply is noted with appreciation.

The rejection of Claim 4 under the second paragraph of 35 U.S.C. §112 is obviated by the cancellation thereof. It is noted in regard thereto that the term "a mixture of essential amino acids" is not recited in the amendment to Claim 1, thereby obviating the rejection as it would apply to Claim 1 as amended. The rejection of Claims 14-21 under the second paragraph of 35 U.S.C. §112 is obviated by the cancellation thereof.

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The rejection of Claims 1-21, now Claims 1-3 and 8-13, under the first paragraph of 35 U.S.C. §112 as failing to provide an enabling disclosure commensurate in scope with the Claims under consideration is, in part, obviated by the foregoing amendments and is otherwise respectfully traversed. Claim 1 is amended to restrict the scope thereof to a composition that is stated in the Final Office Action under reply to be enabled by Applicant's disclosure with the exception of the recitation of the source of proteinase inhibitor. The source of proteinase inhibitor has been restricted to an extract of potato, soy or beans that contains the proteinase inhibitor. These materials are the preferred embodiment of the subject invention and represent the commonly recognized sources of proteinase inhibitor. While Applicant does not agree that such amendment is necessary, the Claims have been so-amended in an effort to conclude the prosecution of the above-identified application.

Applicant respectfully disagrees with the position that it is necessary to restrict the scope of the claims to POT II from potato to meet the requirements of the first paragraph of 35 U.S.C. §112. It is respectfully submitted that proteinase inhibitor from such sources as potato, soy and beans is commonly available and typically provided with an analysis of content of the enzyme therein. Therefore, one of ordinary skill in the art could readily determine by basic calculation how much of a given source to utilize in order to provide an amount of proteinase inhibitor within the scope of the present Claims. Further, while it is recognized that there may be some species variation in terms of proteinase inhibitor content among such sources, the analytical information typically provided with such extracts would permit the calculation to be made. Even if the exact percentage content of a given sample was not provided, it could be determined utilizing art-recognized techniques and, in any event, the range called for in the Claims would more than compensate for batch variation given known average values. It is also commonly recognized that proteinase inhibitors from the claimed sources possesses the ability to block trypsin as well as chymotrypsin. No literature has been made of record whereby those skilled in the art would have reason to doubt that proteinase inhibitors from the claimed sources would not possess this ability. Hence, an undue amount of experiment is not required for one of ordinary skill in the art to make Applicant's compositions with regard to the proteinase inhibitor.

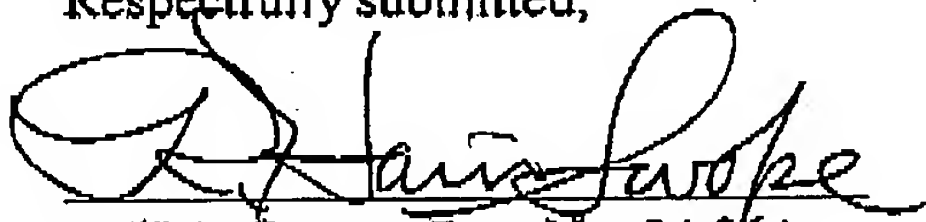
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As with all components of the claimed compositions, only representative members of a general class of material that possess a particular property fall within the scope of Applicant's invention. Hence, only extracts from potato, soy and beans that provide proteinase inhibitor are useful in the composition of the present invention. It is respectfully submitted that there is no basis of record demonstrating that there is such variation among such abstracts as would require restriction of the claims to a single proteinase inhibitor from potato, i.e. POT II. It is respectfully submitted that this material is recognized by those of ordinary skill in the art as possessing the ability to block trypsin and chymotrypsin and further as being generally representative of proteinase inhibitor-containing materials from the claimed sources. There is no evidence to the contrary in the record. Accordingly, it is respectfully submitted that the experiments reported in Applicant's specification clearly enable Claim 1 as amended and the Claims dependent therefrom. The criteria set out in the Final Office Action under reply relating to this rejection have been addressed in detail in the previous response. The positions taken therein apply equally to the rejection discussed herein and will not be repeated. Withdrawal of the rejection is clearly in order and is respectfully requested.

Accordingly, as Claims 1-3 and 8-13 meet the requirements of 35 U.S.C. §112 and are clearly patentable over the citations of record, it is respectfully submitted that this application is in condition for allowance. An early Notice of Allowance is respectfully solicited.

This amendment is filed within the statutory three-month period. Hence it is believed that no fee is required for the filing thereof. If there are any additional fees due in respect to this reply, please charge them to Deposit Account No. 03-3839.

Respectfully submitted,



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